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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/908,453	08/07/97	RUVKUN G	08472/704002

EXAMINER
DO, P

HM12/0413

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176 FEDERAL STREET
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ART UNIT	PAPER NUMBER
1641	19

DATE MAILED: 04/13/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/908,453	Applicant(s) Ruvkun et al.
	Examiner Pensee T. Do	Group Art Unit 1641

☒ Responsive to communication(s) filed on *Sep 25, 1998* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *1* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-28* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-28* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-7, drawn to a polypeptide derived from animal cell, classified in class 530, subclass 350.

II. Claims 8-13, drawn to a purified DNA, vector encoding, cell comprising the polypeptide and a method of producing the recombinant polypeptide classified in class 435, subclasses 69.1 and 91.4.

III. Claim 14, drawn to anti-AGE-1 antibody, classified in class 530, subclass 387.1.

IV. Claims 15-23, drawn to a modulatory compound and the method of identifying said compound, classified in class 424, subclass 192.1.

V. Claims 24-28, drawn to a method of determining longevity of animal, classified in class 435 , subclass 184.1 .

The inventions are distinct, each from the other because:

The polypeptide or protein of invention I is related to the DNA of invention II by virtue of encoding same. The DNA molucule has utility for the recombinant production of the polypeptide or protein in a host cell, as recided in claim 12. Although the DNA molecule and polypeptide or protein are related since the DNA encodes the specifically claimed polypeptide or protein, they are distinct chemical entities, and the polypeptide product can be made from the natural source. Further, the

DNA may be used for processes other than the production of the recombinant polypeptide, such as nucleic acid hybridization assay.

The polypeptide or protein of Invention I is related to the antibody of the invention III by virtue of being the cognate antigen, necessary for the production of antibodies. Although the polypeptide or protein and antibody are related due to necessary steric complementarity of the two, they are distinct inventions because they are physically and functionally distinct chemical entities, and because the polypeptide or protein can be used in another and materially different process from the use for production of the antibody, such as in a pharmaceutical composition in its own right, or to assay or purify the cognate receptor of the protein , or in assays for the identification of agonists or antagonists of the receptor protein.

Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide or protein may be used for the production of the antibody of Invention III, or as a reagent for in vitro assays.

Inventions II and III are distinct and unrelated wherein the antibody of invention III can be neither made by nor used by the method of invention II.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for GroupIII, restriction for examination purposes as indicated is proper.

Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention II is a method of making and Invention III is a method of use.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group IV, restriction for examination purposes as indicated is proper.

Inventions III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention III is a product which is not used by the invention V, a method of use.

Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group V, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is (703) 308-4398. The examiner can normally be reached on Mon.- Fri. from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0196.

JAMES C. HOUSEL 4/12/99
SUPERVISORY PATENT EXAMINER

Pat. Examiner

Pensee T. Do